REMARKS

Applicants believe that all claims are allowable in light of the amendment, arguments and the accompanying Declaration under 37 CFR 1.131

Claim 28 has now been cancelled, and we apologize for failing to do so, as intended, in our previous response. This addresses sections 1 and 2 of the Official Action.

Regarding Section 3 of the official action, Claims 1, ,7,12, 13, 15-17, 19, 24, 30, 31 and 33 are rejected under 35 USD 103 (a) as being unpatentable over Cao in view of Hajjar.

We previously submitted an argument why this rejection fails to establish a prima facie case for obviousness, and that it is improper to combine these references. We reiterate that argument.

In the response to argument section, page 20 of the Official Action, the Examiner states: "*It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the dispersion and amplitude compensation disclosed by Cao to each of a plurality of optical systems as taught by Hajjar et al. in order to advantageously compensate a large number of signals in a larger optical network.*"

However, this is a mere assertion based on hindsight and does not establish a motivation or suggestion to combine the cited references. The examiner has failed to demonstrate where or how such a motivation can be found.

In order to prevent hindsight analysis, there must be some motivation or suggestion to combine specific prior art in such a way as to arrive to the combination claimed in the patent at issue. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Furthermore, although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." In re Mills 916 F.2d at 682, 16 USPQ2d at 1432; In re Fitch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir.

1992). See also, e.g., Yamanouchi Pharmaceutical Co., Ltd. v. Danbury Pharmacal, Inc., 231 F.3d 1339, 1343 (Fed. Cir. 2000): "*the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test of obviousness.*", and Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d at 1371-1372 (Fed. Cir. 2000), "*Combining prior art references without evidence or a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.*"

Accordingly, applicants respectfully contend that the examiner has failed to establish a prima facie case of obviousness as the examiner has not met the burden of articulating a motivation to combine the references, let alone supporting the articulated motivation with actual evidence.

This is not surprising as there is no motivation to combine. These two references are in different fields of endeavor, and solve different problems. Although the Cao patent teaches the compensation of optical signals for chromatic dispersion within a fibre optic transmission system, there are no teachings with respect to the satisfaction of dispersion requirements of interconnected optical systems, specifically where those systems have different requirements due to fibre length or type which affect the slope of the dispersion. The Hajjar patent teaches only a method of interconnecting optical sources and receivers and does not address in any way the complications arising from fibre optic transmission systems. These are two unrelated patents which a person skilled in the field would not have any reason to combine.

In any event applicants respectfully disagree that the Hajjar et al. reference is applicable as prior art against the instant patent application. The Hajjar reference was filed on Aug. 7, 2000, based on provisional applications filed May 26, 2000 and June 6, 2000. A further Declaration made by the first named inventor accompanies this response and declares that the present invention was conceived on or before April 5, 2000, which predates the Hajjar filing, in order to remove this 35 USC §§102(e) reference. Accordingly, the rejections of these claims under 103(a) are believed overcome.

Similar arguments apply to the remainder of the claims. Accordingly, all of the remaining claims are now in allowable form, and withdrawal of the rejections and allowance of the application is requested.

No fee is believed due for this submission. **However, Applicant authorizes the Commissioner to debit any required fee from Deposit Account No. 501593, in the name of Borden Ladner Gervais LLP. The Commissioner is further authorized to debit any additional amount required, and to credit any overpayment to the above-noted deposit account.**

It is submitted that this application is now in condition for allowance, and action to that end is respectfully requested.

Respectfully submitted,

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JMM/dbm
Encl.
Declaration